

REMARKS/ARGUMENTS

In the Office Action mailed June 4, 2008, claims 2-7, 17-22, and 24-29 were rejected. Additionally, claim 23 was objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicants hereby request reconsideration of the application in view of the amendments and the below-provided remarks.

For reference, claims 5, 17, 25, and 27 are amended. In particular, claims 5 and 25 are amended to correctly apply the principle of antecedent basis. Claims 17 and 27 are amended to further clarify the orientation of the laser with respect to the top layer. No claims are added or canceled.

Allowable Subject Matter

Applicants appreciate the Examiner's review of and determination that claims 23 and 30 recite allowable subject matter. In particular, the Office Action states that claim 30 is allowed and claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections under 35 U.S.C. 112, second paragraph

Claims 5, 25, and 26 were rejected under 35 U.S.C. 112, second paragraph. Specifically, the Office Action states that the limitation "the contact pad" of claims 5, 25, and 26 lacks antecedent basis. Applicants appreciate the Examiner's observation. The claims are amended to address the issue of antecedent basis. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. 112, second paragraph, be withdrawn.

Claim Rejections under 35 U.S.C. 102 and 103

Claims 3, 7, 17, 20-22 and 27-29 were rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hauer et al. EP 0 942 302 A2 (hereinafter Hauer). Additionally, claims 2-5, 7, 17, 20-22, 24, and 27-

29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hauer with Mueller-Fiedler 5,577,142. (hereinafter MF). Additionally, claims 2-7, 17-22, and 24-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hauer with MF and further in view of Wang 6,947,224 (hereinafter Wang) and Johnson WO 01/01497 (hereinafter Johnson). However, Applicants respectfully submit that these claims are patentable over Hauer, MF, Wang, and Johnson for the reasons provided below.

Independent Claim 17

Claim 17 recites “a top layer on the planarization layer, wherein the laser is mounted on the top layer” (emphasis added).

In contrast, Hauer does not disclose a layer mounted on a top layer on a planarization layer. Hauer merely describes a laser mounted in a depression of the planarization layer. The top layer 2, as relied on in the Office Action, is not directly connected to the laser 12. Hauer, Fig. 2. The top layer is simply an upper substrate which does not serve as a mounting surface for the laser because the laser of Hauer is mounted on the planarization layer. Although Hauer appears to mention a diode mounted on the upper substrate, Hauer does not disclose or teach that the laser is mounted to the upper substrate.

Therefore, Hauer does not disclose or teach mounting the laser on the top layer because Hauer merely shows mounting the laser on the planarization layer. Accordingly, Applicants respectfully assert claim 1 is patentable over Hauer because Hauer does not disclose or teach all of the limitations of the claim.

Independent Claim 27

Applicants respectfully assert independent claim 27 is patentable over Hauer at least for similar reasons to those stated above in regard to the rejection of independent claim 17. In particular, claim 27 recites “a top layer on the planarization layer, wherein the laser is mounted on the top layer” (emphasis added).

Here, although the language of claim 27 differs from the language of claim 1 and the scope of claim 27 should be interpreted independently of claim 17, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 17

also apply to the rejection of claim 27. Accordingly, Applicants respectfully assert claim 27 is patentable over Hauer because Hauer does not disclose or teach mounting the laser on the top layer.

Dependent Claims

Claims 2-7, 18-26, 28, and 29 depend from and incorporate all of the limitations of the corresponding independent claims 17 and 27. Applicants respectfully assert claims 2-7, 18-26, 28, and 29 are allowable based on allowable base claims. Additionally, each of claims 2-7, 18-26, 28, and 29 may be allowable for further reasons.

No *Prima Facie* Rejection

As an additional matter, the rejections of claims 2-5 and 24 are improper because the Office Action does not establish *prima facie* rejections for the claims. In order to establish a *prima facie* rejection of a claim under 35 U.S.C. 103, the Office Action must present a clear articulation of the reason why the claimed invention would have been obvious. MPEP 2142 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. __ (2007)).

Here, the Office Action fails to explain why the limitations of claims 2-5 and 24 would have been obvious because the Office Action simply states that the cited claims are “obvious structure.” Additionally, the Office Action does not present support for the conclusion that claims 2-5 and 24 are “obvious structure.” Therefore, the Office Action fails to establish a *prima facie* rejection for claims 2-5 and 24 because the Office Action does not assert or show how the cited references might teach the language of the claims. Accordingly, Applicants respectfully submit that the rejection of claims 2-5 and 24 under 35 U.S.C. 103(a) should be withdrawn because the Office Action fails to establish *prima facie* rejections for these claims.

Wang is not Prior Art

As an additional matter, in the Office Action, the Examiner asserts that claims 2-5, 7, 17, 20-22, 24, and 27-29 are unpatentable over Hauer with MF and in further view of Wang and Johnson. However, Wang is not prior art under 35 U.S.C. 102 or 103 because Wang was filed on the same date as Applicants’ present application. Therefore,

Wang was not filed before the present application and, therefore, is not prior art with respect to the present application. Accordingly, Applicants respectfully request that the rejections of claims 2-7, 17-22, and 24-29 U.S.C. 103(a) based on the combination of Hauer with MF and in further view of Wang and Johnson be withdrawn.

CONCLUSION

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,

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